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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,011	01/09/2001	Vassil Iliya Ognyanov	317743-103C	7091
25561	7590	03/24/2004	EXAMINER	
JOHN W. RYAN C/O DECHERT LLP PRINCETON PIKE CORPORATION CENTER P.O. BOX 5218 PRINCETON, NJ 08543-5218			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,011	OGNYANOV ET AL.	
	Examiner	Art Unit	
	Brenda L. Coleman	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 43-74 are pending in the application.

This action is in response to applicant's amendment dated December 18, 2003.

Claims 43 and 46 have been amended.

Response to Arguments

Applicant's arguments filed December 18, 2003 have been fully considered with the following effect:

1. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 43, 46-56, 59-65 and 68-74, the applicant's amendments and remarks have been fully considered but they are not persuasive. The applicants' stated that the "applicants have amended claim 43 so that the disputed recitation is now absent in the amended claim". However, claim 62 has not been amended where the definition of R^q, R^r, or R^s are independently Ar, heteroaryl (wherein heteroaryl comprises thienyl, furanyl, thiazolyl, isothiazolyl, oxazolyl, isoxazolyl, or one of the foregoing fused to phenyl, or methylenedioxyphenyl)".

Claim 62 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons of record and stated above.

Applicant is required to cancel the new matter in the reply to this Office action.

2. The applicant's amendment and arguments are sufficient to overcome the 35 USC § 112, second paragraph rejections of claims 43, 46-56, 59-65 and 68-74 labeled paragraph 5a), b) and c) in the last office action, which are hereby **withdrawn**.

In view of the amendment dated December 18, 2003, the following new grounds of rejection apply:

Election/Restrictions

3. Newly submitted claim 43 and claims 44-56, 59-65 and 68-74 dependent thereon as now amended are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: R^{xa} and R^{ya} , where R^{xa} and R^{ya} are a heteroaryl which comprises benzoazolyl, i.e. indolyl or benzodiazolyl which would require additional searching which has not been done in the first or subsequent office actions and was not constructively elected by applicants in response to a restriction requirement therein.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 43 in part are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 43-51, 55-60, 62-65 and 68-74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The definition of R^{23} and R^{24} where the alkyls of R^{23} and R^{24} can be combined to include 1,3-dioxolane or 1,3-dioxane when R^{22} is other than H is not described in the specification for the genus.

Applicant is required to cancel the new matter in the reply to this Office action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


5. Claims 43-49, 52-55, 59 and 61-74 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-13, 15-17, 19, 20 and 29-66 of U.S. Patent No. 6,667,336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

compounds, compositions and method of use of the compounds of the instant invention embrace the compounds of U.S. '336.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brenda Coleman
Primary Examiner Art Unit 1624
March 21, 2004